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ART UNIT 2876	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 27

Application Number: 08/673,642

Filing Date: June 25, 1996

Appellant(s): Rose

Gregory A. Welte

For Appellants

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed 2/22/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after Final filed on 2/22/99 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that there is one group of claims. The claims do not stand or fall together, with the exception of claims 1 and 8, which do stand or fall together.

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,663,547	Ziarno	9/97
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(10) *New Prior Art*

No new prior art reference is cited.

(11) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims: The grounds of rejection set forth in the Final Office Action dated 11/10/98 and herein incorporated.

Claims 1, 3, 5, drawn to the apparatus and method claim 8-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno [5,663,547].

Regarding claim 1, Ziarno discloses a portable unit 100 having a card reader 307. The portable unit communicate with a terminal 120 via wireless communication link such as RF,

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infrared, etc. The use of a wireless modem is considered inherent in light of the use of a wireless communication link. The reader 307 contains 10-15 keys, a display for prompting users in the manner as recited in the claimed manner. The difference is that Ziarno fails to disclose the use of a printer for printing receipt and wireless modem. Since Ziarno is interest in keeping of donations for tax filing purposes, it would have been obvious to incorporate a printer for printing receipts. In this case, the receipts can be used for additional record keeping purposes. Regarding the wireless modem, Ziarno's wireless communication line requires either a transceiver or a modem for transferring data. Although Ziarno does not specifically recites a modem, it would have been obvious to use a wireless modem in his system. The use of a wireless modem is not new. U.S. Pat. Nos. 5,729,542; 5,689,547; 5,682,605; D374,675; 4,759,078 are cited as evidence showing the conventionality of the use of wireless modems in transferring data. Thus, using a wireless modem in Ziarno's wireless communication link is merely a logical design consideration which is not considered novel.

Regarding claim 3, since there will be more than one units to be used, the use of identification codes to identify each unit is necessary to maintain proper operation.

Regarding claim 5, see the discussions regarding claim 1.

Regarding claim 8, see the discussions regarding claim 1.

Regarding claim 9, see the discussions regarding 1. Further, Ziarno is using a typical credit card reader which inherently includes a statement indicating that the transmission has been successfully conducted.

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Regarding claim 11, Ziarno's terminal is considered to include a typical card reader which would meet all limitations set forth in this claim.

(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

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(13) Response to argument

Regarding claims 1, 3, 5, 8-9, 11, reference to Ziarno includes the use of a wireless credit card reader, display prompts, keypad having 10-15 keys, etc. Although Ziarno is silent about the use of the wireless modem, it would have been logical to use a wireless modem for Ziarno's wireless system. References and motivations are provided showing the conventionality of the wireless modems in data communication. Appellant states in page 22, 1st paragraph of the appeal brief that placing a wireless modem in Ziarno's terminal is not allowed. The examiner strongly disagrees. A vast of commercially available, and portable credit card reading systems are connected to telephone line. Replacing a wired-link or a wireless link such as RF, infrared, etc. with a wireless modem merely is a substitution of an art recognized equivalent which should not change the basic operation of the system.

There is no requirement that a reference must show any evidence of record that the prior art which suggests the combinations. In re Sernaker, In re Deminski, etc. It is respectfully submitted that the requirement for 103 obviousness rejection is that the invention was made by applying the knowledge clearly presented in the prior art. It further is not necessary that the reference (or references) actually suggests, expressly or in so many words, changes or possible improvements (see In re Scheckler, 58 CCPA 936, 168 USPQ 716). It is noted that the examiner has carefully provided a parallel structure for making the comparison between the claimed elements to corresponding elements of Ziarno and others. The underlying inventiveness concepts of applicant's claimed invention is a wireless capability of performing a credit transaction; so does

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Ziarno. Therefore, the 103 obviousness rejection is not based on hindsight. In light of appellant's argument, the examiner further submits that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining the references is what the combination of disclosures taken as a whole would suggest to a routineer in the art (see *In re McLaughlin*, 170 USPQ 209). Therefore, one can not show non-obviousness by attacking the references individually where, the rejections are based on combination of references. The examiner is of the view that replacing Ziarno's wireless transmitter/receiver with a wireless modem is obvious in view of the widespread use of the wireless modems for connecting portable devices to a network. The skill set required for making the modification is far within the skill levels of an ordinary skilled artisan.

Applicant specifically argues the use of a printer in Ziarno's system. The examiner disagrees. Providing a printer in a portable device for printing receipt for each transaction is known and old. Although Ziarno does not teach printing a receipt for the user, an ordinary skilled artisan would have been well aware of the use of a printer for printing receipt. Since Ziarno is more concerning with generating a report for tax filing purpose, the data is collected to a central database for printing out a comprehensive contribution report. However, Ziarno's teaching should not be viewed, whatsoever, as an evidence showing that printing a receipt to customer is not possible. This makes very little sense since a part of our very human tendency is to keep record of every financial transaction. Thus, it would have been obvious for an ordinary skilled artisan to arrive such modification. Further, the kind of hand held terminal having a printer for printing receipt

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has been commercially available, i.e., hand held terminals used by UPS, car check-in terminals used by Avis agents, etc. Thus, printing a receipt to a customer would fall in the traditional method of giving customers record of the transactions which is not considered novel.

With regarding claim 3, although it would have been obvious to communicate provide direct communication link in the manner as described by applicant, Ziarno's system can clearly works on a time sharing or frequency, etc. sharing bases to provide optimum operation by reducing the number of base station. As mentioned above, there is no requirement that a reference must show any evidence of record that the prior art which suggests the combinations. In re Sernaker, In re Deminski, etc. It is respectfully submitted that the requirement for 103 obviousness rejection is that the invention was made by applying the knowledge clearly presented in the prior art. Since Ziarno's system is used in large environment which requires several transaction terminals, it would make very little sense if they all work based on direct communication links. An ordinary skilled artisan would have been well aware of multiple access schemes to provide cost efficient operation. The modification set forth with regarding claim 3 is based on the fact that most banking network and credit transaction networks identify their remote terminals by terminal number or code.

Regarding claim 8, see the discussions regarding claim 1.

Regarding claim 9, see In re Scheckler, 58 CCPA 936, 168 USPQ 716 and the reasons set forth in claim 1. Further, a typical electronic credit card reader displays a message, generates a sound, or any other form indicating that a transaction has been approved or accepted.

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Applicant's claimed features are merely well within the skill level and expectations of an ordinary skilled artisan. Let assume for argument shake that Ziarno only interested in off-line transaction, then the use of a printer for printing receipts is strongly implied. This is motivated by our human tendency of keeping record of electronic transactions for billing purposes.

Claim 10 is "unduly" broad, the nature of Ziarno credit card device and the use of a wireless modem to transfer data would meet all claimed limitation. The phrase "enabling ---- never seen - ---" is clearly subjective which does not place any structural and functional limitations in the claim.

Regarding claim 11, the underlying inventiveness of Ziarno's system in remote credit and financial transactions. It would thus be inherent that Ziarno's base station is connected to a credit transaction network which often are part of an ATM network.

In general, appellant's arguments are heavily relied on the specific teachings of Ziarno, excluding the broader technological interpretations of the claimed invention as applied to the notoriously well known and old prior art as a whole. Specifically, the examiner strongly disagrees with appellant's piecemeal analysis on how references and prior art teachings should be combined and viewed accordingly.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thien Le', with a stylized, cursive script.

Thien Le
Primary Examiner
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April 11, 1999